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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/536,937      | 01/12/2006  | Yigal Moscovitz      | U 015786-5          | 8327             |

140 7590 10/15/2007  
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NEW YORK, NY 10023

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| EXAMINER |
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MCELHENY JR, DONALD E

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| ART UNIT | PAPER NUMBER |
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2857

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10/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                         |                  |  |
|------------------------------|-------------------------|------------------|--|
| <b>Office Action Summary</b> | Application No.         | Applicant(s)     |  |
|                              | 10/536,937              | MOSCOVITZ ET AL. |  |
|                              | Examiner                | Art Unit         |  |
|                              | Donald E. McElheny, Jr. | 2857             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-20 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-20 and 41-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/14/07 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-6, 8-20, and 41-49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter and the claimed invention lacks patentable utility.

Please be advised that the "Interim Guidelines for Examination of Patent Applications for Subject Matter Eligibility" was signed on Oct 26, 2005 and posted on the uspto.gov website. The link is:

<http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>

Also see updated (Eighth Edition, Revision 5 (August 2006)) MPEP 2106, which covers algorithm based and computer implemented inventions and the manner in which they may be claimed and find statutory basis under 35 U.S.C. 101.

These claims are directed to an inventive algorithm couched in method and data model type claims, which states the inventive gist as either data computations per se, or a data set (i.e. model) per se, that lacks the algorithm results implemented into the real physical world.

The system claims call for various means, but at best the basis for such are the algorithm calculations, and as evidenced from the method claims that claim corresponding steps. There is no disclosure in the written specification nor drawings for any specific structure to carry out the various means, no unique circuitry nor computer code nor even a specified flow chart for the algorithm for enabling a computer implemented software embodiment. Claims where the inventive gist is directed either

explicitly only to an abstract idea, or verbal description of a mathematical algorithm, or (even where and when disclosed and enabling) to a computer running an abstract idea algorithm process, or general inventive algorithm process (or equivalent system), and lack any requisite real world practical utility with either a physical transformation, or useful, tangible and concrete results, or lack the clear physical transformation into the real world of the algorithm/data results or physical tangible relationship with the real world of the calculated algorithm results, are considered non-statutory under the updated "Guidelines". Note that under current updated Office policy even when exists a claimed physical input sensor supplies the real-world input data, or a computer system is recited, such does not place the claimed invention into the domain of statutory subject matter. It is the claimed algorithmic basis invention which is analyzed under the Guidelines to determine if it meets the required statutory subject matter conditions set forth therein.

Applicants' arguments have been considered but are not deemed persuasive for the following reasons.

New claims 41-49, directed to a model (i.e. data set per se) is outright directed to only mere data that is not one of the statutory categories of invention permitted under 35 U.S.C. 101, and thus finds no statutory basis in law. Any implied steps in those claims are just that, desired or implied steps that have no patentable weight even if taken as an implied product by process, as the end product per se is what is given any potential patentable weight so as to determine its difference over other prior art products; and here there is no statutory product as the claims are left to mere data

content and definitions thereof. While applicants have argued the claimed invention has a desired or potential practical use in the real world, the claims must first be of a statutory category of 35 U.S.C. 101, and then also have that tangible practical use evident within the body of the claim. Neither of these conditions have been met for claims 41-49. Nor the latter for other remaining claims.

Applicants make remarks regarding "structure" of the model. Such is not physical world structure, but only data relationships or data definitions of abstract nature. Applicants make remarks in the context of the data (i.e. model) or a claim feature "can be", "can produce", "used in the art", which amount to intended use and find no actual real world implementation recited within the claims. Such implied or intended uses do not establish actual claimed statutory basis.

Note that even those method claims which currently recite "query" or "queries" still read upon mere additional computer software algorithm steps which have not been yet clearly claimed and defined as being externally related to the external real world, such as a user query. The "inquiring ..." of independent claim 41 drawn to a data set is not given weight for multiple reasons, as it is only an intended use, only in the preamble, and within a data (i.e. model) per se type claim. These are additional reasons why the claimed invention lacks a tangible real world relationship basis for a finding of statutory subject matter.

3. The following is a quotation of the second and fourth paragraphs of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

4. Claims 1-6, 8-20, and 41-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims fail to completely set forth a real world practical use implementation or a useful, concrete and tangible result that is statutory subject matter in basis. For these reasons the claims therefore appear incomplete in claiming essential portions of the disclosed invention that includes a statutory subject matter implementation basis (if such exists in the specification as filed). The body of these claims appear to fail to ever accomplish an end result of any useful, concrete and tangible real world practical nature that is statutory subject matter based, and thus are unclear how and when such any inventive desired result and inventive purpose as set forth in their preamble is ever reached and accomplished. Throughout the claims the various calculations appear to never be further used, nor how they cooperate, for any useful real world end result that is a physical transformation into the real world, or a useful, concrete and tangible that is beyond a mere abstract idea or human actions that are mental thought process. Note that even when sensor sources and computer supported basis were explicitly recited for such calculations that the current updated computer implemented invention "Guidelines" state that such data gathering and calculation supportive structure/steps fail to give statutory weight to such type abstract idea or mathematical algorithm inventions.

Because the claims lack essential portions to support the invention as to support and meet a statutory basis criteria, they appear to be incomplete in setting forth the intended invention. Therefore, all claims appear as being incomplete for omitting essential steps/structure for supporting such desired results and missing essential and necessary relationships and statutory subject matter criteria, and such omission amounting to a gap between the steps that are recited. See MPEP § 2172.01.

Note claim 41 is further indefinite as it is not a proper claim as it is not a sentence (which end with a period). Therefore the claim appears it may be incompletely recited.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald McElheny, Jr. whose telephone number is 571-

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272-2218. The examiner can normally be reached on Monday-Thursday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eliseo Ramos, can be reached on weekdays at telephone number 571-272-7925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donald E. McElheny, Jr.  
Primary Examiner  
Art Unit 2857